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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,763	12/21/2001	L. Jeffrey Kapner III	K35A0882	3826
35219	7590	04/05/2006	EXAMINER	
WESTERN DIGITAL TECHNOLOGIES, INC.			O'STEEN, DAVID R	
ATTN: SANDRA GENUA			ART UNIT	
20511 LAKE FOREST DR.			PAPER NUMBER	
E-118G			2623	
LAKE FOREST, CA 92630			DATE MAILED: 04/05/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/035,763		KAPNER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	David R. O'Steen		2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Notice***

- 1) Art Units 2611, 2614 and 2617 have changed to 2623. Please make all future correspondence indicate the new designation 2623.

***Oath/Declaration***

- 2) The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: One of the Applicants' signatures has been omitted.

***Claim Rejections - 35 USC § 102***

- 3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Russo (US 6,025,868). Russo discloses a method of recording and accessing a pay per view program using a personal video recorder, the personal video recorder being accessible by the user (col. 3, lines 5-9), the method comprising: a) determining a pay per view program to be transmitted to a personal video recorder (cols. 9 and 10, lines 61-67 and 1-11); b) transmitting the pay per view program to the personal video recorder, free of the user's request (col. 10, lines 13-19); c) recording the transmitted pay per view program in the personal video recorder (col. 10, lines 13-19); and d) after

recording the transmitted pay per view program: displaying a user interface on a display device coupled to the personal video recorder, the user interface including a title of the recorded pay per view program (cols 10 and 11, lines 58-67 and 1-2); and allowing the user to access the recorded pay per view program (col. 11, lines 2-9).

As regards Claim 14, Russo discloses that the pay per view program is recorded on a hard disk (col. 7, lines 43-52).

As regards Claim 15, Russo discloses that allowing the user to access the recorded pay per view program further comprises receiving payment authorization (col. 10, lines 20-38).

As regards Claim 16, Russo discloses that (a) comprises determining the pay per view program to be transmitted to the personal video recorder based on a user profile (also know as viewer preferences) (col. 10, lines 5-11).

As regards Claim 17, Russo discloses that (a) comprises determining a the pay per view program to be transmitted to the personal video recorder based on an list of selected pay per view programs (col. 10, lines 4-5).

As regards Claim 18, Russo discloses a personal video recorder for receiving a pay per view program (col. 3, lines 5-9), the personal video recorder comprising: at least one content delivery path for receiving the pay per view program (fig. 1.2 and col. 3, lines 51-53); an external interface configured to facilitate communications between the personal video recorder and a provider of the pay per view program (fig. 1.12 and cols. 3 and 4, lines 62-67 and 1-2); and a controller (fig. 1.10 or, more specifically, 2.150 inside fig. 1.10) connected to the content delivery path and the external interface (col. 4,

lines 3-5), the controller configured to receive a schedule for the pay per view program via the external interface (col. 4, lines 62-65), to determine when there is at least one content delivery path having an available status at a scheduled time for the pay per view program, and to request a receipt of the pay per view program on the content delivery path having the available status (col. 9, lines 55-61).

As regards Claim 19, Russo discloses a storage device connectable to the controller for storing the pay per view program (fig. 1.14 and col. 4, lines 15-18).

As regards Claim 20, Russo discloses that the storage device is a hard disk drive (col. 7, lines 43-52).

As regards Claim 21, Russo discloses a viewer control interface (such as remote control, fig. 2.163) connectable to the controller (via the infrared receiver, fig. 2.162), the viewer control interface configured to transmit signals to the controller indicating a viewer selection of the pay per view program (col. 9, lines 38-47).

### ***Claim Rejections - 35 USC § 103***

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlarb (US 2004/0078823) in view of Haddad (US 6,072,982). As regards Claim 1, Schlarb discloses a method of selecting a pay per view program to be transmitted to a program receiver, the method comprising: a) obtaining a schedule of

pay per view programs each programs having a title and at least one transmission time and an associated transmission channel for each transmission time (fig. 3.302); b) generating a menu (such as an EPG) comprising the titles of at least one pay per view program, based on the schedule (figure 3); c) providing the menu to a display device for display to the user (paragraph 17, lines 6-9); and d) receiving from the user a selection by title of the pay per view program from the menu to be received by the program receiver (paragraph 20, lines 6-7). Schlarb fails to disclose e) determining a potential transmission time of the pay per view program to be received by the program receiver based on the at least one transmission time in the schedule of pay per view programs. Haddad discloses determining a potential transmission time of the pay per view program to be received by the program receiver based on the at least one transmission time in the schedule of pay per view programs (col. 8, lines 35-38).

Schlarb and Haddad are analogous because they both come from the same field of endeavor, namely the field of pay-per-view systems.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to provide the scheduling system of Haddad to the PPV system of Schlarb to allow the viewer more flexibility in watching PPV events.

As regards Claim 2, Haddad further discloses f) determining if an availability status of a content delivery path is available at a predetermined time prior to the potential transmission time; g) if the availability status of the content delivery path is available at the predetermined time prior to the potential transmission time, requesting transmission of the pay per view program at the potential transmission time on the

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associated transmission channel; (col. 10, lines 5-12) and h) if the availability status of the content delivery path is not available at the predetermined time prior to the potential transmission time, repeating (e) – (g) until the availability status of the content delivery path is available (col. 10, lines 12-25).

As regards Claim 5, Haddad further discloses receiving the pay per view program at the potential transmission time on the associated transmission channel (col. 12, lines 4-17).

As regards Claim 7, Haddad further discloses j) storing the pay per view program; and k) making the pay per view program available for viewing (col. 3, lines 23-31).

As regards Claim 8, Haddad further discloses wherein the pay per view program is stored on a hard disk drive (cols. 6 and 7, lines 67 and 1-7).

As regards Claim 9, Haddad further discloses that (k) further comprises displaying a notification that the pay per view program is available for display (col. 9, lines 28-32).

As regards Claim 10, Schlarb further discloses that (d) further comprises receiving a payment authorization from the user (paragraph 23, lines 11-18).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlarb (US 2004/0078823) in view of Haddad (US 6,072,982) and in further view of Schultheiss (US 6,545,722). As regards Claim 3, Scharb and Haddad jointly disclose the method of Claim 2. Haddad further discloses i) determining if a program is scheduled to be recorded during the potential transmission time (col. 10, lines 8-12); ii)

if a program is scheduled to be recorded during the potential transmission time (i.e. other program segments on order), determining that the availability status of the content delivery path is not available (col. 10, lines 8-12); and iii) if no programs are scheduled to be recorded during the potential transmission time, at the predetermined time prior to the potential transmission time (col. 11, lines 6-10). Schlarb and Haddad do not disclose (1) displaying a change channel request to change to the associated transmission channel for the potential transmission time; (2) waiting a predetermined wait for response time for a response to the change channel request from the user; (3) if the response from the changed channel request received from the user is positive, determining that the availability status of the content delivery path is available; (4) if the response to the change channel request received from the user is negative; determining if the availability status of the content delivery path is not available; and (5) if the response to the change channel request is not received from the user within the predetermined wait for response time for receiving the change channel request, determining that the availability status of the content path is available. Schultheiss discloses (1) displaying a change channel request to change to the associated transmission channel for the potential transmission time; (2) waiting a predetermined wait for response time for a response to the change channel request from the user; and (5) if the response to the change channel request is not received from the user within the predetermined wait for response time for receiving the change channel request, determining that the availability status of the content path is available (by changing the channel) (col. 11, lines 5-13). It is inherent that if the receiver is not tuned to the correct



channel (the channel on which the scheduled program is being broadcast), then the recorder is unable to record the scheduled program and the availability status of the content delivery path (channel) is not available. Likewise, if the receiver is tuned to the appropriate channel on which the scheduled program is being broadcast, then it is true that the status of the content delivery path is available.

Schlarb, Haddad, and Schultheiss are analogous because they both come from the same field of endeavor, namely the field of interactive audiovisual systems.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to provide the reminder system of Schultheiss to the PPV system of Schlarb and Haddad to insure that the recording is not missed.

As regards Claim 4, Haddad discloses that there are a plurality of content delivery paths (channels) each content delivery path having an associated availability status, and wherein (f) is repeated until it is determined that a respective content delivery path has an availability status of available or that all content delivery paths have an associated availability status of not available (cols. 10 and 11, and lines 66-67 and 1-13).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlarb (US 2004/0078823) in view of Haddad (US 6,072,982) in further view of Yoshinobu (US 5,699,104). While Schlarb and Haddad jointly disclose the method of Claim 5, they do not disclose displaying a screen overlay to prevent viewing of the pay per view program during receipt of the pay per view program. Yoshinobu discloses displaying a screen

overlay to prevent viewing of the pay per view program during receipt of the pay per view program (cols. 10 and 11, lines 48-59 and 8-20).

Schlarb, Haddad, and Yoshinobu are analogous because they both come from the same field of endeavor, namely the field of pay per view television.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to provide the overlay system of Yoshinobu to the PPV system of Schlarb and Haddad to insure that no unauthorized viewing occurs.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (US 6,025,868) in view of Haddad (US 6,072,982) and Schultheiss (US 6,545,722). While Russo discloses the method of Claim 11, he fails to disclose that after a) and before b): i) determining a potential transmission time and associated transmission channel for the pay per view program to be transmitted to the personal video recorder; ii) determining if a program is scheduled to be recorded during the potential transmission time; iii) if a program is scheduled to be recorded during the potential transmission time, repeating (i)-(iv); and iv) if there is no program scheduled to be recorded during the potential transmission time: 1) displaying a change channel request to change to the associated transmission channel for the potential transmission time at a predetermined time prior to the potential transmission time; 2) waiting a predetermined wait for response time for a response to the channel request from the user; 3) if the response to the change channel request received from the user is positive, proceeding to (b); 4) if the response to the change channel request received from the user is negative repeating (i)-(iv); and 5) if the response to the change channel

request is not received from the user within the predetermined wait for response time for receiving the change channel request, proceeding to (b). Haddad discloses i) determining a potential transmission time and associated transmission channel for the pay per view program to be transmitted to the personal video recorder (col. 8, lines 35-39); ii) determining if a program is scheduled to be recorded during the potential transmission time (col. 10, lines 8-12); iii) if a program is scheduled to be recorded during the potential transmission time, repeating (i)-(iv) (col. 10, lines 13-25); and iv) if there is no program scheduled to be recorded during the potential transmission time (col. 10, lines 8-12). Schultheiss discloses 1) displaying a change channel request to change to the associated transmission channel for the potential transmission time at a predetermined time prior to the potential transmission time; 2) waiting a predetermined wait for response time for a response to the channel request from the user; 3) if the response to the change channel request received from the user is positive, proceeding to (b); 4) if the response to the change channel request received from the user is negative repeating (i)-(iv); and 5) if the response to the change channel request is not received from the user within the predetermined wait for response time for receiving the change channel request, proceeding to (b) (col. 11, lines 5-13). It is inherent that if the receiver is not tuned to the correct channel (the channel on which the scheduled program is being broadcast), then the recorder is unable to record the scheduled program. Likewise, if the receiver is tuned to the appropriate channel on which the scheduled program is being broadcast, then it is able to receive the transmitted pay per view program to the personal video recorder.

Russo, Haddad, and Schultheiss are analogous art because they both come from the same field of endeavor, namely the field of interactive audiovisual systems.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to provide the reminder system of Schultheiss to the PPV system of Russo augmented by the scheduling system of Haddad (provided to improve scheduling) to insure that the scheduled recording is not missed.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (US 6,025,868) in view of Yoshinobu (US 5,699,104). While Russo discloses the method of Claim 11, he fails to disclose wherein (b) further comprises displaying a screen overlay to prevent viewing of the pay per view program while transmitting the pay per view program to the personal video recorder. Yoshinobu discloses wherein (b) further comprises displaying a screen overlay to prevent viewing of the pay per view program while transmitting the pay per view program to the personal video recorder (cols. 10 and 11, lines 48-59 and 8-20).

Russo and Yoshinobu are analogous because they both come from the same field of endeavor, namely the field of pay per view television.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to provide the overlay system of Yoshinobu to the PPV system of Russo to insure that no unauthorized viewing occurs.

### **Conclusion**

5) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ottensen (US 5,654,747) discloses a system for local storage of


pay per view programs. Billing occurs in Ottensen only after the program has been viewed. Safadi (US 2001/0051037) also discloses a system for local storage of pay per view programs that charges the user only after playback. Vallone (US 6,642,939) discloses an Electronic Program Guide that works in concert with a Personal Video Recorder. This system includes a "suggestions" subsystem that recommends programs to viewers as well as a subsystem that checks for any recording conflicts and alerts the user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. O'Steen whose telephone number is 571-272-7931. The examiner can normally be reached on 8:30 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600